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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,996	12/04/2000	Steven E. Schultz	1247 P 160	6877

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EXAMINER

STRIMBU, GREGORY J

ART UNIT	PAPER NUMBER
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3634

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/729,996

Applicant(s)

SCHULTZ, STEVEN E.

Examiner

Gregory J. Strimbu

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2003 and 14 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 11-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 32-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Election/Restrictions***

Applicant's election with traverse of Groups I and III in Paper No. 10 is acknowledged. The traversal is on the ground(s) that claim 29 requires "selecting an actuator based on the desired distance the nose is to extend through the outward opening", because the groups relate to the same class, and because the search is not unduly burdensome. This is not found persuasive because selecting an actuator based on the desired distance the nose is to extend through the outward opening is not the same as selecting an actuator based on its aesthetic appearance such as selecting the actuator based on its color. Additionally, the mere fact that the groups I and II can be classified in the same class does not, on its face, preclude a restriction requirement. All that is required is art recognized separate status which is clearly demonstrated by the classification into the two different subclasses in class 049. Finally, the applicants argument that the search is not unduly burdensome is not persuasive because the search for the invention of group I does not require at least the search in class 49/506 in addition to searches in other classes which cover a system of assembling a tilt latch. Therefore, the search would be unduly burdensome.

Next, the applicant traverses the restriction requirement because the examiner has provided on basis for the requirement of an election of species and the criteria for grouping the species has not been provided. This is not found persuasive because the allegations listed above show that the applicant has not analyzed the examiner's action in the context of the established practice for requiring an election of species as established in Chapter 800 of the MPEP. It is a well established practice that a

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requirement to elect a single species is a holding by the examiner that the plural species, as claimed, are patentably distinct, i.e., each capable of supporting separate patents. See MPEP 808.01(a) and MPEP 809.02(a). If the applicant is of a different view, the applicant need merely state on the record that the species are not patentably distinct. Neither the examiner nor the applicant need present any reasoning that the plural species, as claimed, are patentably distinct. Of course, the species that are not patentably distinct are obvious in view of one another. The applicant's response implies that the various species are not considered to be patentably distinct from one another. If such is the case, then the applicant must clearly admit such on the record. The requirement is still deemed proper and is made FINAL.

Accordingly, claims 11-31 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected species, the requirement having been traversed in paper no. 10.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 32 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Simpson '353. Simpson '353 discloses a tilt latch 40 for a sash window comprising a housing 42 having an outward end opening (not numbered, but seen in figure 4), a latch

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bolt 44 disposed within the housing, the latch bolt having a nose 81, an actuator 48, a post 106 located on one of the latch bolt and the actuator and a notch 95 located on the other of the latch bolt and actuator, the post or notch being positioned such that when the latch bolt is fully extended through the outward end opening, a portion of the nose is positioned within the housing.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson '353 as applied to claims 32 and 35 above. Simpson '353 is silent concerning the actuator having a notch.

However, it would have been obvious to one of ordinary skill in the art to provide the actuator with the notch 95 and the latch bolt 44 with the post 106 since it has been held that mere reversal of the essential working parts of a device involves no more than routine skill in the art. *In re Einstein*, 8 USPQ 167.

### ***Response to Arguments***

Applicant's arguments filed July 7, 2003 have been fully considered but they are not persuasive.

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With respect to the applicant's arguments concerning Simpson '353, the examiner respectfully disagrees. It should first be noted that the term "nose" is a very broad term and should not be limited to only an angled portion of a protrusion as argued by the applicant. Simpson '353 clearly discloses a nose 81 comprising the part of the latch bolt 44 extending to the right from the body segment 84 in figure 4. Therefore, only a portion of the nose 81 of Simpson '353 extends beyond the opening in the housing when the latch bolt is in the extended position. Finally, the applicant's description of the nose in the specification and figures does not limit the nose to only an angled portion. Thus, the applicant has not sufficiently limited the definition of nose for purposes of allowance. Accordingly, it is suggested that the applicant amend the claims to specifically recite the structure that defines the nose in order to place the case into a better form for allowance. The post 106 extends from the latch bolt since it is hooked into the notch 95 of the latch bolt.

### ***Conclusion***

**THIS ACTION IS NOT MADE FINAL.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 703-305-3979. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3597 for regular communications and 703-305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-

2168.

A handwritten signature in black ink, appearing to read "Gregory J. Strimbu", with a stylized flourish extending from the end.

Gregory J. Strimbu  
Primary Examiner  
Art Unit 3634  
March 22, 2004